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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,778	12/17/2001	Douglas D. Sjostrom	02-35-0385 / 00167-456001	4406

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06/03/2003

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary

Application No.

10/015,778

Applicant(s)

SJOSTROM, DOUGLAS D.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 4-24 are rejected under 35 U.S.C. 102 (e) as being anticipated by Pintor et al (U.S. 6,482,217).

Regarding claim 1, figures 6 and 7, Pintor et al disclose a device having all the limitations as recited in the above listed claims, including: an outer member (21) has a cutting edge; and wherein a helical knife (46) couples to the outer member for rotation, wherein a portion of the helical knife (46) has an edge (23) configured to slice into tissue (col.10, lines 35-48) and extending distally the cutting edge of the outer member (21).

Regarding claims 2 and 4, wherein an inner member (34) receives within the outer member. The helical knife (46) is located at a distal end of the inner member; and wherein the inner member (34) defines an aspiration opening (labeled as lumen 20 in col. 17, lines 15-22).

Regarding claims 5-7, wherein the edge includes a helical edge and the helical knife (60) includes a helical channel (30 is considered a helical channel in fig. 6); wherein the helical channel has a pitch (46) that increases from the distal end to the proximal end (fig. 6, col. 9, lines 11-40); and wherein the helical channel terminates in an opening through a wall of the inner member.

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Regarding claims 8-11, wherein the device further includes a hub (fig. 9, item 84); wherein the outer member (21) defines a fluid (col. 17, lines 17-21). The cutting edge (23) is located at a distal end of the outer member; and wherein the outer member (21) tapers to the cutting edge.

Regarding claims 12-13, wherein the cutting edge includes a circumferential and a circular in shape (fig. 7, col. 10, lines 39-49).

Regarding claims 14-17, wherein the cutting edge is part circumferential, circular and oblong in shape (figs 6, 7 and col. 10, lines 35-48); and wherein the outer member includes a shield portion (fig. 5a).

Regarding claims 18-19, wherein a method of cutting including to slice into tissue with a helical knife (46) and cutting the tissue with the cutting portion; wherein cutting the tissue includes into pieces (col. 8, lines 34-41).

Regarding claims 20-24, wherein the helical knife (46) is on an inner member (34) and the cutting portion is on an outer member (21); wherein transporting the cut tissue along a helical channel defines by the helical knife (46); wherein aspirating the cut tissue is through the inner member; and wherein aspirating fluid (col. 17, lines 17-21) is through an opening in the outer member (21).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Pintor et al (U.S.6,482,217).

Pintor et al are explained as before. Although, Pintor et al do not disclose the inner member and the outer member is in the range of about 0.0005 to 0.002 inches. It would have been obvious matter of design choice to modify the inner member and the outer member is in the range of about 0.0005 to 0.002 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re-Aller, 105 USPQ 233.

Response to Arguments

3. Applicant's arguments filed 2/26/2003 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

vn *vn*.
June 1, 2003

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700